

REMARKS

Claims remaining in the present Patent Application are Claims 1-8. Claims 1 and 4 are herein amended. No new matter is added as a result of the amendments presented herein. The Applicants respectfully request reconsideration of the above captioned patent application in view of the remarks presented herein.

Finality

The Office Action Summary as well as the first paragraph of the “Detailed Action” indicate that the present Office Action is non-final. However, the “Conclusion” indicates that present Office Action is made final. Applicants assume the present Office Action is non-final.

Examiner Interview Summary

On August 22, 2006, Applicants’ representative conducted an Examiner Interview with Examiner Mondt. The Examiner was requested to withdraw finality of the Office Action mailed June 8, 2006.

Applicants thank the Examiner for the interview.

35 U.S.C. § 103(a) Rejections

Claims 1-3 stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over admitted prior art (“APA”) and further in view of Reczek et al. (US 4,798,974, “Reczek”). Applicants have carefully reviewed the cited references and assert that embodiments of the present invention as recited in Claims 1-3 are not rendered obvious by APA in view of Reczek.

With respect to Claim 1, Applicants respectfully assert that the rejection applies impermissible hindsight in the rejection. Applicants respectfully assert that the motivation to combine APA in view of Reczek and add the recited switch is not found in the prior art, but rather are found only in Applicants’ disclosure.

Applicants respectfully assert that there is no teaching or suggestion in APA or Reczek or knowledge of the general art that a combination of APA in view of Reczek and addition of the recited switch, as coupled in the recited claims, would improve either reference. For example, the rejection concedes that “Reczek et al. provide(s) a remedy” to the relevant situation. Applicants respectfully assert that a reference that “provides a remedy” would not be

seen by one of ordinary skill in the art as motivating a different remedy when the reference is complete as to those teachings.

In *In re Fulton*, 391 F.3d 1195, 73 USPQ2d 1141 (Fed. Cir. 2004), the court emphasized that the proper inquiry is “whether there is something in the prior art as a whole to suggest the *desirability*, and thus the obviousness, of making the combination....” Applicants respectfully assert that there is no suggestion in the prior art as to the desirability of the combination proposed by the rejection.

The rejection concedes that neither APA nor Reczek nor a direct combination of the two teach the recited switch. The rejection further argues that “insertion of said switch between the bias supply line, output terminal and ground (is) straightforward in the art.” Even if, *arguendo*, such insertion is “straightforward,” Applicants respectfully assert that the inventive initiative to insert said switch is not “straightforward.”

The rejection further argues, “...so long as (the rejection) takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant’s disclosure, such a reconstruction is proper.” Per *Al-Site Corp. v. VSI Int’l Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999), “[t]he

level of skill in the art cannot be relied upon to provide the suggestion to combine references.”

Applicants respectfully assert that there is no suggestion in the prior art as to the desirability of the specific combination proposed by the rejection, and that the rejection relies on impermissible hindsight to combine disparate elements, motivated and guided by the claims of the present application.

For this reason, Applicants respectfully assert that all rejections over APA in view of Reczek are overcome, and respectfully solicit allowance of Claims 1-8.

In addition with respect to Claim 1, Applicants respectfully assert that APA in view of Reczek fails to teach or suggest the limitation of first and second inputs “for controlling said switch” as recited by amended Claim 1. In contrast, Reczek teaches a switch T4 with a single input for controlling said switch (node 35). Applicants respectfully assert that the taught single input for controlling a switch fails to teach or fairly suggest the limitation of first and second inputs “for controlling said switch” as recited by amended Claim 1. APA fails to correct this deficiency of Reczek.

For this additional reason, Applicants respectfully assert that Claim 1 overcomes the rejections of record, and respectfully solicit allowance of this Claim.

Further with respect to Claim 1, Claim 1 recites a switch with at least five terminals. In contrast, Reczek teaches a switch T4 with exactly three terminals (32, 33 and 35). Applicants respectfully assert that the taught three terminals fails to teach or fairly suggest the limitation of at least five terminals as recited by Claim 1. APA fails to correct this deficiency of Reczek.

For this further reason, Applicants respectfully assert that Claim 1 overcomes the rejections of record, and respectfully solicit allowance of this Claim.

Still further with respect to Claim 1, the rejection alleges that FET T4, voltage terminal 18, voltage generator 16 and their specific coupling illustrated in Figure 2, in conjunction with APA and with the addition of another switch, fairly suggests the limitations of Claim 1. Applicants respectfully traverse. Claim 1 recites, in part, a controlling input coupled to a first N-well bias supply line, and an output terminal coupled to a P-type substrate. Thus, Claim 1 requires a switch coupled to N type material (via the N-well bias supply line) and P type material (substrate). All elements of T4 and the substrate bias

voltage are coupled to the same type of material, “n-conducting, well like semiconductor zone (B)2.”

By teaching a switch coupled to only one type of material, Reczek actually teaches away from embodiments of the present invention, as recited by Claim 1. For this still further reason, Applicants respectfully assert that Claim 1 overcomes the rejections of record, and respectfully solicit allowance of this Claim.

Claims 2-8 depend from independent Claim 1. Applicants respectfully assert that these claims overcome the rejections of record as they depend from an allowable base Claim, and respectfully solicit allowance of these Claims.

In addition with respect to Claim 2, Applicants respectfully assert that APA in view of Reczek fails to teach or fairly suggest the limitation, “electrically couple said P-type substrate to said ground” as recited by Claim 2. In contrast, Reczek teaches a coupling of “n-conducting, well like semiconductor zone (B)2” to ground (Figure 2). Applicants respectfully assert that the taught coupling an n-well fails to teach or fairly suggest the recited coupling of a P-type substrate.

For this additional reason, Applicants respectfully assert that Claim 2 overcomes the rejections of record, and respectfully solicit allowance of this Claim.

In addition with respect to Claim 3, Applicants respectfully assert that the rejection mischaracterizes the function of Reczek switch T4 as, “Vdd is the very supply voltage that is switched on, for which operation the electronic switch T4 is inserted.” As Applicants understand, switch T4 does not switch Vdd. Rather, T4 switches “output 17 of the substrate bias voltage generator (which generates a negative voltage substrate bias)... to a circuit point which carries ground potential Vss” (column 3 line 55 – column 4 lines 33) and Figure 2. Applicants respectfully assert that switch T4 cannot possibly switch Vdd as alleged by the rejection as neither terminal of switch T4 is coupled to Vdd.

It is unclear to Applicants how the alleged teaching of T4 is supposed to teach a limitation of Claim 3. However, since the alleged teaching of T4 is demonstrably incorrect, Applicants respectfully assert that such alleged teaching does not teach or fairly suggest a limitation of Claim 3. For this additional reason, Applicants respectfully assert that Claim 3 overcomes the rejections of record, and respectfully solicit allowance of this Claim.

Claims 4-8 stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over admitted prior art (“APA”) in view of Reczek et al. (US 4,798,974, “Reczek”) and further in view of Nakazato et al. (US 5,386,135, “Nakazato”). Applicants have carefully reviewed the cited references and assert that embodiments of the present invention as recited in Claims 1-3 are not rendered obvious by APA in view of Reczek and further in view of Nakazato.

Applicants respectfully reiterate that all rejections over APA in view of Reczek are overcome due to impermissible use of hindsight as previously argued with respect to Claim 1, and respectfully solicit allowance of Claims 1-8.

Claims 2-8 depend from independent Claim 1. Applicants respectfully assert that these claims overcome the rejections of record as they depend from an allowable base Claim, and respectfully solicit allowance of these Claims. With respect to Claims 4-8, Applicants respectfully assert that Nakazato does not suggest a combination with APA in view of Reczek that corrects the deficiencies of APA in view of Reczek.

In addition with respect to Claim 4, Applicants respectfully assert that APA in view of Reczek and further yet in view of Nakazato does not teach or suggest the limitation of “a second control input coupled to a second N-well bias supply line” as recited by Claim 4. Applicants respectfully assert that the

rejection improperly equates the bias supply lines taught by Nakazato with the recited “control inputs (to a switch).” Applicants respectfully assert that there is no teaching of utilizing the taught bias supply lines as the recited “second control input (to a switch).” Furthermore, Nakazato does not teach a switch for such alleged “second control input” to control. Applicants respectfully assert that APA and/or Reczek do not correct this deficiency of Nakazato.

For this additional reason, Applicants respectfully assert that Claim 4 overcomes the rejections of record, and respectfully solicit allowance of this Claim.

With respect to Claim 5, Applicants respectfully assert that APA in view of Reczek and further in view of Nakazato does not teach or suggest the limitation of “said switch is operable to electrically couple said P-type substrate to said ground when a bias voltage is present on said second N-well bias supply line” as recited by Claim 5. Applicants do not find a citation in the rejection that allegedly teaches this limitation.

For this additional reason, Applicants respectfully assert that Claim 5 overcomes the rejections of record, and respectfully solicit allowance of this Claim.

With respect to Claim 6, Applicants respectfully assert that APA in view of Reczek and further in view of Nakazato does not teach or suggest the limitation of “wherein said switch is operable to electrically couple said P-type substrate to said substrate bias supply line when a substrate bias voltage is present on said substrate bias supply line” as recited by Claim 6. Applicants do not find a citation in the rejection that allegedly teaches this limitation.

Furthermore, with respect to Claim 6, the rejection mischaracterizes the function of Reczek switch T4 as, “Vdd is the very supply voltage that is switched on, for which operation the electronic switch T4 is inserted.” Applicants respectfully assert that switch T4 does not switch Vdd. Rather, T4 switches “output 17 of the substrate bias voltage generator (which generates a negative voltage substrate bias)... to a circuit point which carries ground potential Vss” (column 3 line 55 – column 4 lines 33) and Figure 2. Applicants respectfully assert that switch T4 cannot possibly switch Vdd as alleged by the rejection as neither terminal of switch T4 is coupled to Vdd.

It is unclear to Applicants how the alleged teaching of T4 is supposed to teach a limitation of Claim 6. However, since the alleged teaching of T4 is demonstrably incorrect, Applicants respectfully assert that such alleged teaching does not teach or fairly suggest a limitation of Claim 6. For this

additional reason, Applicants respectfully assert that Claim 6 overcomes the rejections of record, and respectfully solicit allowance of this Claim.

With respect to Claims 7 and 8, Applicants respectfully assert that the rejection applies impermissible use of hindsight in the rejection of these Claims. The rejection assembles a bag of components that allegedly teach various elements of these Claims. The rejection then invents a switch not taught by the cited art, and further invents the functions recited for said switch. Applicants respectfully note that there is no citation to the cited art indicating where such function is taught.

For these additional reasons, Applicants respectfully assert that Claims 7 and 8 overcome the rejections of record, and respectfully solicit allowance of these Claims.

CONCLUSION


Claims remaining in the present patent application are Claims 1-8. The Applicants respectfully request reconsideration of the above captioned patent application in view of the remarks presented herein.

The Examiner is invited to contact Applicants' undersigned representative if the Examiner believes such action would expedite resolution of the present Application.

Respectfully submitted,

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